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REMARKS

Applicants appreciate the Office Action of June 28, 2005. Applicants have not provided the requested translations for the reasons discussed below. Applicants have amended Claims 3-6, 8 and 13 as set out above and, therefore submit that these claims are in compliance with 35 U.S.C. § 112. Applicants respectfully submit that the pending claims contain statutory subject matter for at least the reasons discussed herein. Furthermore, Applicants submit that the pending claims are patentable over the cited references for at least the reasons discussed herein.

The Translations

The Office Action requests that translations be provided of the priority document JP-2001-287883 and of JP-06-322920 cited in the International Preliminary Request. Applicants are not required to furnish such translations as Applicants have not asserted the priority date and neither reference has been asserted against Applicants. Accordingly, Applicants have not provided the requested translations as these translations may be very costly to IBM.

The Section 112 Rejections

Claims 3-6, 8 and 13 stand rejected under 35 U.S.C. § 112, second paragraph, as "being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." *See* Office Action, page 5. In particular, with respect to Claim 3, the Office Action states that it is not clear to what "the commodity sales number" of Claim 3 refers. *See* Office Action, page 5 (emphasis in original). Applicants have amended Claim 3 as set out above to recite "the commodity sales number of said plurality of kinds of unit goods at said shop." Accordingly, Applicants respectfully submit that Amended Claim 3 is in compliance with section 112 and, therefore, request that the rejection with respect to Claim 3 be withdrawn.

With respect to Claim 4, the Office Action states that is not clear to what "the forecasted commodity sales number" of Claim 4 refers. *See* Office Action, page 6. Applicants have amended Claim 4 to recite "wherein said computer implemented district sales number forecasting section calculates the forecast sales number of said commodity within said

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predetermined district for each unit advertising district residing within said predetermined district performing sales promotion activity at the same time" to clarify the language of Claim 4. Accordingly, Applicants respectfully submit that Amended Claim 4 is in compliance with section 112 and, therefore, request that the rejection with respect to Claim 4 be withdrawn.

With respect to Claim 5, the Office Action states that the use of the term "forecast index" is unclear. *See Office Action, pages 6-7.* Claim 5 has been amended to recite "on the basis of said calculated forecast index, said forecast ratio and a forecast number of visitors coming to said predetermined shop." Only one forecast index is calculated, *i.e.*, "a forecast index representing a customers' purchasing trend for each commodity in each unit advertising district performing sales promotion activity at the same time." The forecast sales number of said commodity at said predetermined shop is calculated on the basis of the calculated forecast index, said forecast ratio and a forecast number of visitors coming to said predetermined shop. Accordingly, Applicants respectfully submit that Amended Claim 5 is in compliance with section 112 and, therefore, respectfully request that the rejections with respect to Claim 5 be withdrawn.

With respect to Claim 6, the Office Action states that it is unclear to what "the forecasted number of visitors refers." *See Office Action, page 7.* Claim 6 has been amended to recite "by comparing a ratio of said forecast commodity sales number in said unit advertising district calculated on the basis of the past achievement to the forecast number of visitors coming to said predetermined shop and a ratio of the forecast commodity sales number at said predetermined shop to the forecast number of visitors coming to said predetermined shop." *See Office Action, page 7.* Claim 6 depends from Claim 5 and Claim 5 only refers to "visitors coming to said predetermined shop." Accordingly, Applicants respectfully submit that Amended Claim 6 is in compliance with section 112 and, therefore, respectfully request that the rejections with respect to Claim 6 be withdrawn.

With respect to Claim 8, the Office Action states that recitation "a forecast average visitor unit price" is unclear. *See Office Action, page 8.* Applicants have amended Claim 8 to recite "a forecast average visitor unit price at the predetermined shop." *See Office Action, page 8.* Accordingly, Applicants respectfully submit that Amended Claim 8 is in compliance with

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section 112 and, therefore, respectfully request that the rejections with respect to Claim 8 be withdrawn.

Claim 13 stands rejected under 35 U.S.C. § 112, second paragraph, as "being incomplete for omitting essential steps, such as omission amounting to a gap between the steps." *See Office Action*, page 8. The Office Action further states that "the omitted steps are: the calculation of the commodity sales selling index." *See Office Action*, page 8. Applicants respectfully submit that Claim 13 recites a "commodity selling index" not a "commodity sales selling index" or a "commodity sales index" as stated in the Office Action. Applicants respectfully submit that the commodity selling index T according to some embodiments of the present invention is discussed throughout the specification. *See, e.g.*, specification, page 10, lines 17-21 and page 11, lines 8-18. Furthermore, a calculation step for the commodity selling index is not required because according to some embodiments of the present invention the commodity selling index is not calculated, but set, and may be used in the calculation of other values. *See, e.g.*, page 10, lines 17-21. Accordingly, Applicants submit that Claim 13 is in compliance with section 112 for at least these reasons and, therefore, respectfully request that the rejections with respect to Claim 13 be withdrawn.

Claim 13 has also been amended to correct typographical errors therein as set out above.

The Section 101 Rejection

Claims 1-16 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. *See Office Action*, page 10. In particular, the Office action asserts that the "claimed invention, as a whole, does not produce a useful, concrete and/or tangible result and claims 1-16 are deemed to be directed to non-statutory subject matter." *See Office Action*, page 11.

As stated in the M.P.E.P.:

The plain and unambiguous meaning of section 101 is that any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may be patented if it meets the requirements for patentability set forth in Title 35, such as those found in sections 102, 103, and 112. The use of the expansive term "any" in section 101 represents Congress's

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intent not to place any restrictions on the subject matter for which a patent may be obtained beyond those specifically recited in section 101 and the other parts of Title 35. . . . Thus, it is improper to read into section 101 limitations as to the subject matter that may be patented where the legislative history does not indicate that Congress clearly intended such limitations.

Alappat, 33 F.3d at 1542, 31 USPQ2d at 1556. . . .

Federal courts have held that 35 U.S.C. 101 does have certain limits. First, the phrase "anything under the sun that is made by man" is limited by the text of 35 U.S.C. 101, meaning that one may only patent something that is a machine, manufacture, composition of matter or a process. See, e.g., *Alappat*, 33 F.3d at 1542, 31 USPQ2d at 1556; *Warmerdam*, 33 F.3d at 1358, 31 USPQ2d at 1757 (Fed. Cir. 1994). Second, 35 U.S.C. 101 requires that the subject matter sought to be patented be a "useful" invention. Accordingly, a complete definition of the scope of 35 U.S.C. 101, reflecting Congressional intent, is that any new and useful process, machine, manufacture or composition of matter under the sun that is made by man is the proper subject matter of a patent.

The subject matter courts have found to be outside the four statutory categories of invention is limited to abstract ideas, laws of nature and natural phenomena. . . .

See M.P.E.P. § 2106 (emphasis added). The subject matter of Claims 1-16 are not abstract ideas (see Applicants' previous Response), laws of nature or natural phenomena. In fact, Claims 1-8 recite a computer implemented system, Claims 9-12 recite a computer implemented method and Claims 13-16 recite a computer program product, all of which are clearly statutory subject matter. The Office Action merely asserts:

The sales values are not used in any tangible, concrete or useful way such as using the calculated values to determine required staffing levels for a store/group of stores, benchmarking the performance of stores/groups of stores, determining the success/performance of a specific promotional campaign, managing inventory to meet future demand or the like.

See Office Action, page 11. No references are cited to indicate that these things have been declared "useful," it is merely taken for granted. Applicants respectfully submit that the Office Action improperly reads limitations into section 101 where the legislative history does not indicate that Congress clearly intended such limitations. Accordingly,

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Applicants submit that Claim 1-16 recite statutory subject matter for at least these reasons and, therefore, respectfully request withdrawal of the 101 rejections with respect to these claims.

The Section 103 Rejection

Claims 1-16 stand rejected as being unpatentable under 35 U.S.C. § 103(a) over United States Patent No. 5,237,498 to Tenma et al. (hereinafter "Tenma") in view of United States Publication No. 2002/0169657 to Singh et al. (hereinafter "Singh") and in further view of *Uncovering the Multiple Impact of Retail Promotion on Apparel Store Performance* by Lam (hereinafter "Lam"). See Office Action, page 12.

To establish a *prima facie* case of obviousness, the prior art reference or references when combined must teach or suggest *all* the recitations of the claims, and there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See M.P.E.P. § 2143. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See M.P.E.P. § 2143.01(citing *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990)). As emphasized by the Court of Appeals for the Federal Circuit, to support combining references, evidence of a suggestion, teaching, or motivation to combine must be clear and particular, and this requirement for clear and particular evidence is not met by broad and conclusory statements about the teachings of references. *In re Dembicza*k, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). In another decision, the Court of Appeals for the Federal Circuit has stated that, to support combining or modifying references, there must be particular evidence from the prior art as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

Furthermore, as stated by the Federal Circuit with regard to the selection and combination of references:

This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a

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person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion....

In re Sang Su Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). As discussed in further detail below, Applicants submit that the Official Action has failed to establish a *prima facie* case of obviousness as the cited reference does not disclose or suggest each of the recitations of the claims and a proper motivation to combine the references in the manner cited in the claims has not been established.

Initially, Applicants note that throughout the Office Action it is asserted that particular calculation steps are lacking in the claims and that the claims should be amended to include such steps. *See, e.g.*, Office Action, pages 12 and 13. Applicants respectfully submit that there is nothing in the patent law that makes it improper to claim "determining" without "performing" the calculations. Thus, Applicants have not amended the claims as suggested in the Office Action.

Furthermore, the Office Action further states that the "sections" of the claims represent "non-functional descriptive material." *See, e.g.*, Office Action, pages 12 and 13. Applicants respectfully submit that each of the elements as claimed, for example, the "district sales number forecasting section," represent particular aspects of the present invention. Therefore, the Office Action can not just make broad statements that these elements do "not change the overall functionality of the system." *See, e.g.*, Office Action, pages 12 and 13.

Furthermore, the Office Action also relies on "Official Notice" as to certain teachings in the art. *See e.g.*, Office Action, pages 75. Applicants request that the Examiner support such assertions with citations to a reference or references as the Official Notice taken in the Office Action appears to be so vague that Applicants cannot properly address the combination of the "Official Notice" with the cited references. *See* § M.P.E.P. 2144.03.

With regard to independent Claim 1, Applicants note that Claim 1 recites a specific configuration of computer implemented systems according to some embodiments of the present invention. For example, Claim 1 recites, in part:

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a computer implemented district sales number forecasting section configured to calculate the forecast sales number of a commodity within said predetermined district for each unit advertising district residing within said predetermined district performing sales promotion activity at the same time by use of a predetermined advertising medium; and

a computer implemented shop sales number forecasting section configured to calculate the forecast sales number at each shop by distributing the forecast sales number of said commodity in said unit advertising district to each shop within said unit advertising district.

Claim 1, emphasis added. The highlighted recitations of Claim 1 are never specifically discussed in the rejection. The Office Action goes on for ten pages citing multiple pages of Tenma in rejecting Claim 1, the pages including Figures from the cited references, but never points to the portions of the cited references which allegedly teach the recitations of Claim 1.

Tenma discusses a system and method for computing profits. However, Applicants submit that an obviousness rejection may not be properly established without finding each of the recitations of Claim 1 in the prior art or a suggestion to modify the prior art to result in the recitations of Claim 1. As discussed above, the Office Action does not even mention many of the recitations of Claim 1. The cited portions of Tenma do not appear to describe the specific system recited in Claim 1. Furthermore, the Office Action fails to provide a convincing line of reasoning as to why Tenma would be combined with Singh and/or Lam to provide the teachings of Claim 1 and, in fact, never discusses the specific recitations of Claim 1. It appears that the Office Action is asserting that all computer implemented profit management systems are obvious because Tenma teaches a computer implemented profit management system and method. The Office Action, however, never cites to any reference or even takes Official Notice that the specific calculations with the specific district, advertising unit and shop specifications recited in Claim 1 are known. Applicants respectfully request that the Examiner support the assertions in the Office Action by citation to specific portions of a reference that addresses the specific recitations of the claims. The fact that Tenma discusses the things discussed on pages 13-17 of the Office Action does not mean that Tenma discusses the specific recitations of Claim 1, which are not addressed. Applicants, therefore, submit that the rejection of Claim 1 is based on general interpretations of Tenma and unsupported conclusory allegations of motivation to combine

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Tenma, Singh and/or Lam to result in the recitations of Claim 1. Accordingly, Applicants submit that a *prima facie* case of obviousness has not been established with respect to Claim 1.

Claim 5 is an independent system claim that recites, in part:

a computer implemented district purchasing trend forecasting section configured to calculate a forecast index representing a customers' purchasing trend for each commodity in each unit advertising district performing sales promotion activity at the same time by means of a predetermined advertising medium;

a computer implemented shop purchasing trend forecasting section configured to calculate a forecast ratio of said forecast index at a predetermined shop within said unit advertising district to said forecast index in said unit advertising district; and

a computer implemented shop commodity sales number calculating section configured to calculate the forecast sales number of said commodity at said predetermined shop on the basis of the said forecast index, said forecast ratio and a forecast number of visitors coming to said predetermined shop.

Claim 5, emphasis added. Claim 9 is an independent method claim that recites, in part:

calculating a forecast total commodity sales number within said predetermined district;

calculating a forecast ratio of a forecast commodity sales number per unit visitor number in said unit district to a forecast commodity sales number per unit visitor number in said predetermined district; and

calculating a forecast total commodity sales number within said unit district using said forecast total commodity sales number and said forecast ratio.

Claim 9, emphasis added.

As discussed above with respect to Claim 1, the Office Action appears to assert that the recitations of Claims 5 and 9 are known because Tenma discusses a system and method for computing profits. Applicants submit that the rejection of these claims is based on the use of hindsight in light of the present disclosure. Applicants request that the Examiner support the assertions that the recitations of Claims 5 and 9 are known in the art by pointing to specific portions of the cited references and not just generally discussing the entirety of the references. Accordingly, Applicants submit that the Official Action fails to establish a *prima facie* case of obviousness with respect to independent Claims 5 and 9.

With regard to independent Claim 12, Applicants submit that a *prima facie* case of obviousness has not been established for these claims for reasons analogous to those discussed

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above with reference to Claims 1, 5 and 9. In particular, Applicants submit that merely because it is known to calculate profits based on various business metrics does not establish that it was known to use the specific recitations of Claim 12. Accordingly, Applicants request that the Examiner support the rejection of Claim 12 with specific citations to references or withdraw the rejections.

As discussed above, Applicants submit that a prima facie case of obviousness has not been established with respect to the independent Claims 1, 5, 9 and 12. As such, Applicants submit that a prima facie case of obviousness also has not been established with respect to the claims that depend from these claims.

CONCLUSION

In light of the above discussion, Applicants submit that the present application is in condition for allowance, which action is respectfully requested.

Respectfully submitted,



Elizabeth A. Stanek
Registration No. 48,568

USPTO Customer No. 46590
Myers Bigel Sibley & Sajovec
Post Office Box 37428
Raleigh, North Carolina 27627
Telephone: 919/854-1400
Facsimile: 919/854-1401